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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,841	04/27/2005	Jordi Tormo I Blasco	5000-0118PUS1	4917

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BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER
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SZNAIDMAN, MARCOS L

ART UNIT	PAPER NUMBER
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1611

NOTIFICATION DATE	DELIVERY MODE
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05/21/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/532,841	<b>Applicant(s)</b> TORMO I BLASCO ET AL.	
	<b>Examiner</b> MARCOS SZNAIDMAN	<b>Art Unit</b> 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10 pages / 04/27/05 and 08/24/05</u> .                        | 6) <input type="checkbox"/> Other: _____                          |



## **DETAILED ACTION**

This office action is in response to applicant's filing of April 27, 2005.

### ***Status of Claims***

Claims 1-10 are currently pending and are the subject of this office action.

Claims 1-10 are presently under examination.

### ***Priority***

The present application is a 371 of PCT/EP03/12776 filed on 11/14/2003, and claims priority to foreign application: GERMANY 102 53 587 filed on 11/15/2002.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 provides for the use of “the compounds of formula I and II for preparing a composition suitable for controlling harmful fungi which are rice pathogens”, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cotter et. al. (EP 0 988 790, cited by applicant).

Claim 1 recites a fungicidal mixture comprising, as active components: 1) the compound of formula I (a strobilurine, from now on Orysastrobin) and 2) the compound of formula II (a triazolopyrimidine, from now on TP1) in a synergistically effective amount.

For claim 1, Cotter et. al. teach a fungicidal mixture comprising: 1) compounds of formula I (see paragraph [0001], triazolopyrimidines) and 2) synthetic strobilurines (see paragraph [0001], item (C)) in a synergistically effective amount.

Although Cotter et. al. do not specifically disclose the compounds of the instant claimed mixture (TP1 and Orysastrobin), at the time of the invention, it would have been *prima facie* obvious for a person of ordinary skill in the art to combine any of the structures comprised by formula I, including the instant claimed compound: TP1, with any of the synthetic strobilurines, including the instant claimed Orysastrobin, because it will be obvious to try (i.e. choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success, see MPEP 2142, section III), thus resulting in the practice of claim 1 with a reasonable expectation of success.

Claim 2, recites the same limitations as claim 1, wherein the weight ratio between Orysastrobin (a strobilurine) and TP1 (a triazolopyrimidine) is from 100:1 to 1:100.

For claim 2, Cotter et. al. further teach that the weight ratio of a strobilurine and a triazolopyrimidine of formula I is suitably from 100:1 to 1:100 (see paragraph [0021].

At the time of the invention, it would have been *prima facie* obvious for a person of ordinary skill in the art to combine Orysastrobin and TP1 in a ratio as taught by Cotter et. al., thus resulting in the practice of claim 2 with a reasonable expectation of success.

Claim 3, recites the same limitations as claim 1, wherein the mixture further comprises a liquid or solid carrier.

For claim 3, Cotter et. al further teach that the compounds can be co-formulated with carriers and or additives known in the art (see paragraph [0022]).

At the time of the invention, it would have been *prima facie* obvious for a person of ordinary skill in the art to co-formulate Orysastrobin and TP1 with carriers as thought by Cotter et. al., thus resulting in the practice of claim 3 with a reasonable expectation of success.

Claims 4, 5 and 8 recite a method for controlling harmful fungi which are rice pathogens (*Pyricularia oryzae*), which comprises treating fungi with an effective amount of 1) Orysastrobin (a synthetic strobilurine) and 2) TP1 (a triazolopyrimidine) in synergistically effective amounts.

For claims 4, 5 and 8, Cotter et. al. teach a method of treating a broad range of phytopathogenic fungi (including *Pyricularia*) on monocotyledoneous plants, such as barley and wheat, rice and turf grasses, etc. (see paragraphs [0015]-[0017]), with a fungicidal mixture comprising: 1) compounds of formula I (see paragraph [0001], triazolopyrimidines) and 2) synthetic strobilurines (see paragraph [0001], item (C)) in a synergistically effective amount.

Although Cotter et. al. do not specifically disclose the compounds of the instant claimed mixture (TP1 and Orysastrobin), at the time of the invention, it would have been *prima facie* obvious for a person of ordinary skill in the art to combine any of the structures comprised by formula I, including the instant claimed compound: TP1, with any of the synthetic strobilurines, including the instant claimed Orysastrobin, because it will be obvious to try (i.e. choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success, see MPEP 2142, section III), and



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further use the mixture to treat any phytopathogenic fungi on monocotyledoneous plants, including rice as thought by Cotter et. al., thus resulting in the practice of claims 4, 5 and 8 with a reasonable expectation of success.

Claims 6, 7 and 9, recite the same limitations as claim 4, wherein the mixture is applied in an amount of from 5 g/ha to 2000 g/ha (claim 6) of from 0.001 to 1 g/kg of seed (claim 7 and 9).

For claims 6, 7 and 9, Cotter et. al. teach that the application rate for the triazolopyrimidine of formula I is suitable in the range of 1 to 2,000 g/ha (see paragraph [0018]) and that the optimal rate for the strobilurines will, however, depend on the crop under cultivation and the level of infestation of the fungus, and can readily be determined by established biological tests (see paragraph [0020]).

The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient needed to achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, the optimization of ingredient amounts would have been obvious at the time of applicant's invention, thus resulting in the practice of claims 6, 7 and 9 with a reasonable expectation of success.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/574,005. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim a fungicidal mixture for treating rice-pathogenic fungi comprising a mixture of TP1 (a triazolopyrimidine) and a strobilurine (Orysastrobin in the instant application, and Trifloxystrobin in the copending application).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/563,606. Although the conflicting claims are not identical, they are not

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patentably distinct from each other because both applications claim a fungicidal mixture for treating rice-pathogenic fungi comprising a mixture of TP1 (a triazolopyrimidine) and a strobilurine (Orysastrobin in the instant application, and Kresoxim-methyl in the copending application).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCOS SZNAIDMAN whose telephone number is (571)270-3498. The examiner can normally be reached on Monday through Thursday 8 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward can be reached on 571 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MLS  
April 23, 2008

/MP WOODWARD/  
Supervisory Patent Examiner, Art Unit 1615